

REMARKS

This communication responds to the Office Action mailed on September 29, 2005. Claims 1 and 8 are amended, claims 6 and 12-24 are withdrawn, no claims are canceled, and no claims are added. As a result, claims 1-24 are now pending in this Application. The title has been amended to conform more closely to requirements for certain international applications, and is not intended to limit the scope of the claims in any way. Formal drawings are supplied herewith. No new matter has been added.

In the Drawings

Formal drawings are supplied herewith, each labeled as "REPLACEMENT SHEET". No amendments have been made to the figures. It is believed that the drawings are in compliance with 37 CFR 1.84.

§112 Rejection of the Claims

Claim 7 was rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Since the rejection is based on the dependence of claim 7 from previously withdrawn claim 6, the Applicant respectfully requests that claim 7 also be withdrawn. After claim 7 is withdrawn, the rejection under 35 USC § 112 should be moot.

§101 Rejection of the Claims

Claims 1 and 8 were rejected under 35 USC § 101 as being directed to non-statutory subject matter. After mentioning a test involving the "technological arts," the Office Action goes on to make the rejection based on two points: (1) the alleged requirement that the "non-functional descriptive material is not capable of causing a functional change in the computer. Thereby the claim does not define any structural interrelationships between the data structure (information) and other claimed aspects of the invention (see MPEP 2106)"; and (2) "that the claims do not produce any concrete or tangible 'results' ...".

First, since the use of a “technical arts” test is mentioned in the rejection, it may be well to consider the court’s precedential opinion in *Ex parte Carl A. Lundgren* (Appeal No. 2003-2088; Paper No. 78; Application No. 08/093,516), which declares that there is “no technical arts test.” As noted in the *Lundgren* opinion at page 6, in the last sentence of the first full paragraph : “[w]e have reviewed these cases and do not find that they support the examiner’s separate ‘technical arts’ test.” Therefore, the Applicant assumes that the technical arts test has no bearing on the instant rejection.

Second, with respect to 35 USC § 101, the court in *Alappat* noted that the “... plain and unambiguous meaning of section 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in sections 102, 103, and 112. The use of the expansive term “any” in section 101 represents Congress’s intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35.... Thus, it is improper to read into section 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations.” *In re Alappat*, 33 F.3d at 1542, 31 USPQ2d 1545, 1556 (Fed. Cir. 1994) (en banc). The AT&T court stated that the “... scope of 35 U.S.C. § 101 is the same regardless of the form or category of invention in which a particular claim is drafted. *AT&T*, 172 F.3d at 1357, 50 USPQ2d at 1451 . See also *State Street*, 149 F.3d at 1375, 47 USPQ2d at 1602.

For example, as noted by the *Alappat* court, “*Alappat* admits that claim 15 would read on a general purpose computer programmed to carry out the claimed invention, but argues that this alone also does not justify holding claim 15 unpatentable as directed to nonstatutory subject matter. We agree. We have held that such programming creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software. . . . The Supreme Court has never held that a programmed computer may never be entitled to patent protection. . . . Consequently, a computer operating pursuant to software may represent patentable subject matter, provided, of course, that the claimed subject matter meets all of the other requirements of Title 35.” *In re Alappat* at 1558.

Finally, it is respectfully noted that “a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” M.P.E.P. § 2106.IV.B.1(a). A data structure may constitute “a ... logical relationship among data elements, designed to support specific data manipulation functions.” M.P.E.P. § 2106.IV.B.1. The claimed “plurality of digital content items” included in a memory and “associated with the final price related to the base price and the option price” clearly falls under the ambit of a computer-readable medium encoded with a data structure, and therefore comprises statutory subject matter.

In order to avoid unduly prolonging the time required to prosecute this matter, claims 1 and 8 have been amended to clarify that the sales computer is “to calculate a final price,” and not for reasons related to patentability. These claims go on to recite that “one of the plurality of digital content items is associated with the final price related to the base price and the option price by a final pricing formula”. No new matter has been added. The calculation of a final price related to base pricing and option pricing using a computer is clearly not “[d]escriptive material that cannot exhibit any functional interrelationship with the way computing processes are performed”, and therefore constitutes a statutory machine that should not be rejected under 35 U.S.C. § 101. *See* M.P.E.P. §2106.IV.B.1(b). The final price is also provided as a concrete and tangible result. Therefore, the Applicant respectfully traverses the present rejection asserted under § 101 with respect to claims 1 and 8, and requests reconsideration by the Examiner.

§102 Rejection of the Claims

Claims 1-5 and 7-11 were rejected under 35 USC § 102(e) as being anticipated by Cansler (U.S. 6,725,257 B1; hereinafter “Cansler”). The Applicant does not admit that Cansler is prior art and reserves the right to swear behind this reference at a later date. In addition, because the Applicant asserts that the Office has not shown that Cansler discloses the identical invention as claimed, the Applicant traverses this rejection of the claims.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaa Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It

is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

In the Office Action, it is asserted that Cansler “teaches a digital content pricing system, comprising ... a memory ... including a plurality of digital content items ...”. A careful reading of Cansler reveals that these assertions are incorrect – Cansler describes an apparatus for configuring a product over a network, not a digital content pricing system.

The assertion that Cansler “teaches a digital content pricing system” is incorrect because Cansler is directed to configuring a vehicle. *See* Cansler, Col. 3, lines 41-44. A vehicle or “products other than vehicles” that are to be purchased “from a dealer, vehicle broker, or manufacturer” (see Cansler, Col. 4, lines 27-29) are not the same as the claimed digital content items, defined in the Application to include “on-line novels, software program packages, compact disks, electronic music albums, electronic magazines, movie packages (e.g., similar to or identical to the program content stored on a digital video disk), electronic news services, and similar items” that can be delivered directly to the purchaser over a network. Application, pg. 3, lines 22-25. Thus, the products described by Cansler are not “digital content items” as claimed by the Applicant.

The assertion that Cansler “teaches a memory ... including a plurality of digital content items” is incorrect for similar reasons. Cansler’s memory does not include “a plurality of digital content items,” which comprise the products themselves, as claimed by the Applicant. Instead, Cansler merely describes *information about the products* in a database 46. *See* Cansler, FIG. 2.

Since Cansler does not teach the identical invention claimed, independent claims 1 and 8 (as well as all claims depending from them) are in condition for allowance. Reconsideration and withdrawal of the rejection of claims 1-5 and 7-11 under § 102 is respectfully requested.

CONCLUSION

The Applicant respectfully submits that all of the pending claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney, Mark Muller at (210) 308-5677, or the Applicant's below-named representative to facilitate the prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

TODD A. SCHWARTZ ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
Attorneys for Intel Corporation
P.O. Box 2938
Minneapolis, Minnesota 55402
(612) 349-9592

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By Ann M. McCrackin
Ann M. McCrackin
Reg. No. 42,858

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 29th day of November 2005.

CAROLYN HULSEY
Name

Carolyn Hulsey
Signature